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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/970,892 | 10/05/2001 | Yuki Akiyama | TESJ.0039 | 1850 |
| 7590 | 05/04/2005 | | EXAMINER | DIVINE, LUCAS |
| REED SMITH HAZEL & THOMAS LLP Suite 1400 3110 Fairview Park Drive Falls Church, VA 22042 | | | ART UNIT | PAPER NUMBER |
| | | | 2624 | |

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/970,892 | AKIYAMA, YUKI | |
| | Examiner Lucas Divine | Art Unit 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 October 2001.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 October 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **G, F**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **3**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

4. Claim 2 is objected to because of the following informalities: Examiner interprets the claim to mean that the photographing means includes any one of the three instead of all three included. Examiner believes by reading the specification that applicant means that the photographing means can be a photographing portion, a digital camera, **or** a scanner. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The acronyms '**FD, MD, DVD,**

and P.P.' have not been explained in the specification as to what they represent. For the disclosure to be enabling, the invention needs to be described in a way that allows any person skilled in the art to which it pertains to make the invention, and thus, such a person would need an explanation of what an acronym represents. A clear example of enabling description is on page 4, line 7, where the acronym '**LAN**' is explained as a '**local area network**'. The other acronyms need similar explanations to be enabling.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since the acronyms '**FD, MD, DVD, and P.P.**' have not been explained it is unclear and indefinite as to what they represent. Therefore the claim does not particularly point out what the claimed invention is. These terms must be definite for the claim to be definite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 – 6 and 8 – 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Patel et al. (US 6747692) hereafter as Patel.

Regarding claim 1, Patel teaches a system for reading image information (Fig. 10) comprising:

an image information display member such as a poster (Fig. 10 ref. no. 114, col. 11 line 69, wherein image information is displayed and read); **and**
a mobile communication system for reading an image information portion of said image information display member (mobile communication system 10, shown further in Fig. 5 for explanation and Fig. 6 for mobility demonstration), **wherein said mobile communication system comprise**:

a photographing portion which shoots at least information of said image information portion (Fig. 5 ref. no. 12, col. 5 line 58);
recording means for recording the shot image (col. 6 line 8, wherein the image is recorded into data storage 56 [Fig. 7]); **and**

a display portion which retrieves and displays any of the recorded information (Fig. 5 ref. no. 14, col. 5 line 67).

Regarding claim 2, which depends from claim 1, Patel further teaches **photographing means includes said photographing portion, a digital camera, and a scanner** (digital camera 12, col. 5 line 58, *note: due to claim objection, examiner reads the claim to include one devices listed, see objection above*).

Regarding claim 3, which depends from claim 1, Patel further teaches **the image information stored in said recording means is structured to be transferred to a mobile communication system that another person carries and/or to a system which has a function of a communication terminal** (Fig. 6, wherein the information is transmitted to a user terminal 38F).

Regarding claim 4, which depends from claim 1, Patel further teaches **the image information stored in said recording means is structured to be connected to a net line from a local area network (LAN)** (col. 8 lines 24-26, wherein the communication system can access a LAN and the internet ‘net line’).

Regarding claim 5, which depends from claim 1, Patel further teaches **the image information stored in said recording means can be recorded in a recording medium such as a server system** (the recording means 56 [Fig. 7] is a recording medium in a server system [col. 8 line 66 – col. 9 line 2, Fig. 7 ref. no. 57, wherein the device acts as a server and a terminal]).

Regarding claim 6, which depends from claim 1, Patel further teaches **the image information stored in said recording means can be copied to a recording medium such as an FD, an MD or a DVD as well as P.P** (Fig. 6 ref no. 36, col. 8 lines 21-22, wherein the information is input to data storage 36 in order to perform the network transfers).

Regarding claim 8, which depends from claim 2, Patel further teaches **the image information stored in said recording means can be recorded in a recording medium such as a server system** (the recording means 56 [Fig. 7] is a recording medium in a server system [col. 8 line 66 – col. 9 line 2, Fig. 7 ref. no. 57, wherein the device acts as a server and a terminal]).

Regarding claim 9, which depends from claim 3, Patel further teaches **the image information stored in said recording means can be recorded in a recording medium such as a server system** (the recording means 56 [Fig. 7] is a recording medium in a server system [col. 8 line 66 – col. 9 line 2, Fig. 7 ref. no. 57, wherein the device acts as a server and a terminal]).

Regarding claim 10, which depends from claim 4, Patel further teaches **the image information stored in said recording means can be recorded in a recording medium such as a server system** (the recording means 56 [Fig. 7] is a recording medium in a server system [col. 8 line 66 – col. 9 line 2, Fig. 7 ref. no. 57, wherein the device acts as a server and a terminal]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Patel as applied to claim 1 above, and further in view of Flack et al. (US 6288704) hereafter as Flack.

Regarding claim 7, which depends from claim 1, while Patel teaches means for displaying a desired image and altering the image (Fig. 9) at the time of outputting (col. 6 line 25, the image can be printed and thus it is implied by Fig. 9 and printing that the user can view the data at the time of printing), Patel does not specifically teach **displaying and image in an enlarged manner**.

Flack teaches a mobile handheld device including a camera (116) that can connect to the Internet including **displaying and image in an enlarged manner** (see Figs. 6, 7, 8, wherein the user selects areas of image information do enlarge and it is displayed on the screen).

It would have been obvious to one of ordinary skill in the art to add the zooming/enlarging feature to the system of Patel. The motivation for doing so would have been to easily traverse any and all segments of a large object, thus selecting a smaller part of an image and getting a more detailed view of it (see Flack, col. 3 lines 47-52).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lonka, US 6308084, 10-23-01: teaches a mobile connections device with a camera.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lucas Divine
Examiner
Art Unit 2624

ljd

KING Y. POON
PRIMARY EXAMINER